

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD L. CLARK

Appeal No. 97-3003
Application 08/390,403¹

ON BRIEF

Before MEISTER, STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Edward L. Clark appeals from the final rejection of claims 2, 4 and 10 through 12, all of the claims pending in the application. We reverse and enter a new ground of

¹ Application for patent filed February 16, 1995.

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rejection.

The invention relates to "golf clubs, and more particularly to putters with adjustable putter heads" (specification, page 1). A copy of the appealed claims appears in the appendix to the appellant's main brief (Paper No. 11).

The items relied upon by the examiner as evidence of obviousness are:

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| Guier | 3,191,936 | Jun. 29, 1965 |
| Grant | 4,736,951 | Apr. 12, 1988 |
| Cannan | 4,856,782 | Aug. 15, 1989 |

Claims 2, 4, 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Grant in view of Cannan, and claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Grant in view of Cannan and Guier.

Reference is made to the appellant's main and reply briefs (Paper Nos. 11 and 13) and to the examiner's answer (Paper No. 12) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

Grant, the examiner's primary reference, discloses a golf club comprising a club head 12, a shaft 14 and a pivotal

connection means 18 coupling the club head and shaft in a manner which allows the angle between the two to be adjusted. The examiner concedes (see page 3 in the answer) that this golf club does not meet the limitations in independent claim 11 relating to the socket-type or over-hosel type engagement between the club head and the distal end of the second elongated engagement element.² Nonetheless, the examiner submits that

Cannan teaches a golf club including first and second elongated engagement elements (23, 21) which engage the shaft and club head, respectively. Note column 1, lines 58 and 59 and column 2, lines 2-4 of Cannan which state that the putter head is adapted to engage the distal end of the second element. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the club head of Grant with the connection taught by Cannan in order to provide a more secure connection between the two members [answer, page 3].

Cannan, however, actually discloses a golf club having a "release-jointed shaft for preferential release upon impact with the ground" (column 1, lines 7 through 9). This arrangement is intended to alleviate the sometimes painful

² These particular claim limitations will be discussed further below.

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result of such an impact (see column 1, lines 11 through 29).

As described by Cannan,

[t]he release joint includes a lower link fixed to the lower section of the shaft and an upper link fixed to the upper section of the shaft. The links are pivotally connected for relative rotation in response to impact on the shaft to permit the lower section to rotate relative to the upper section to relieve the stress of impact. The pivot is on a threaded hinge pin which is adjustable to vary the friction within the release joint and thereby the responsiveness of the joint to impact on the shaft [column 1, lines 34 through 43].

There is nothing in Cannan's disclosure of this articulated shaft construction which would have suggested modifying the Grant golf club by providing it with the socket-type or over-hosel type club head engagement features required by independent claim 11. Furthermore, the faulty combination of Grant and Cannan proposed by the examiner finds no cure in Guier's disclosure of a putter having an adjustable sole or lie angle. Accordingly, we shall not sustain either of the 35 U.S.C. § 103 rejections on appeal.

The following rejection is entered pursuant to 37 CFR § 1.196(b).

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Claims 2, 4 and 10 through 12 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.d. 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard has been met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

Independent claim 11 recites the combination of (1) a golfing aid comprising, inter alia, a second elongated engagement element having a distal end, (2) an elongated club shaft and (3) a putter club head. The putter club head is defined as being "adapted for a socket-type or an over-hosel type engagement with the distal end of the second elongated engagement element" wherein "the distal end of said second

elongated engagement element is adapted to engage fixedly the putter club head by insertion into the socket-type putter head or slidably accepting the over-hosel type putter head." The appellant's disclosure, however, indicates that the socket-type and over-hosel type engagements are distinct and mutually exclusive expedients for connecting a putter head and shaft (see, for example, page 4 in the specification). Claim 11 is unclear as to which of these two engagements the putter club head which is set forth as part of the claimed combination is adapted for.³ Thus, the scope of claim 11, and of claims 2, 4, 10 and 12 which depend therefrom, is indefinite. The scope of dependent claims 2, 4, 10 and 12 is further indefinite in that their preambles ("A golfing aid . . .") are inconsistent with the preamble of parent claim 11 ("In combination . . .").

In the event of further prosecution of this application, the examiner would be well advised to evaluate the

³ Contrary to arguments presented throughout the appellant's briefs, the appealed claims do not require the distal end of the second elongated engagement element to be engagable with both a socket-type putter head and a over-hosel type putter head.

patentability of the claimed subject matter in light of Guier as a primary reference. As indicated above, Guier discloses a putter having an adjustable sole or lie angle. The putter includes a shaft 10 and club head 13 joined by a neck 12 of ductile material. As shown in Figure 1, the neck reasonably can be described as comprising first and second elongated engagement elements which are secured together at their proximal ends. The distal end of upper or first engagement element is attached to the shaft (see column 4, lines 39 and 40) and the distal end 30 of the lower or second engagement element is anchored within a hole 31 in the club head (a socket-type engagement). The neck is both ductile enough to be bent or pivoted about its medial portion (where the proximal ends of the two engagement elements meet) to adjust the lie angle and strong enough to maintain the selected angle under the force of a putting stroke (see column 4, line 21 et seq.).

This putter construction would appear to be highly relevant to the subject matter presently recited in claims 2, 4, 10 and 11. In this regard, we would note that, contrary to

the position set forth in the appellant's briefs, these claims make no mention of "conventional" (whatever this means) socket-type or over-hosel type club heads and do not require the distal end of the second elongated engagement element to be engagable, releasably or otherwise, with both types of head, and that claim 10 does not actually recite the plurality of unitary structures mentioned therein as part of the claimed "combination."

In summary:

a) the decision of the examiner to reject claims 2, 4 and 10 through 12 under 35 U.S.C. § 103 is reversed; and

b) a new 35 U.S.C. § 112, second paragraph, rejection of claims 2, 4 and 10 through 12 is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

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37 CFR § 1.196(b) also provides that the appellant,
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise
one of the following two options with respect to the new
ground of rejection to avoid termination of proceedings
(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the
claims so rejected or a showing of facts relating to
the claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED, 37 CFR 1.196(b)

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| JAMES M. MEISTER |) | |
| Administrative Patent Judge |) | |
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| LAWRENCE J. STAAB |) | BOARD OF PATENT |
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